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# TRANSMITTAL OF APPEAL BRIEF

Docket No.  
M&R 3.0-033 CIP

In re Application of: Steven J. Sculler and Mitchell L. Stevelman

Application No.  
09/677,153

Filing Date  
October 2, 2000

Examiner  
R. E. Rhode

Group Art Unit  
3625

Invention: METHOD AND SYSTEM FOR FACILITATING RESELLER TRANSACTIONS

## TO THE COMMISSIONER FOR PATENTS:

Transmitted herewith is the Appeal Brief in this application.

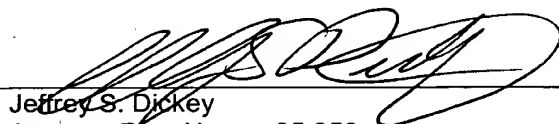
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(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Sculler et al.

Application No.: 09/677,153

Group Art Unit: 3625

Filed: October 2, 2000

Examiner: R. E. Rhode

For: METHOD AND SYSTEM FOR  
FACILITATING RESELLER  
TRANSACTIONS

**APPEAL BRIEF**

MS Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Applicants hereby file this brief on Appeal to appeal from the final rejection of claims 75-112 mailed May 18, 2005. The Commissioner is hereby authorized to charge the fee required by 37 C.F.R. § 1.17(c) and 37 C.F.R. § 41.20(b)(2) for the filing of the brief and fee for the extension of time. The Commissioner is also hereby authorized to charge any other fees

that may be due and owing in connection with this appeal to Deposit Account No. 12-1095.

**REAL PARTY(IES) IN INTEREST**

The real party in interest is M&R Marking Systems, Inc., the assignee of the present application.

**RELATED APPEALS AND INTERFERENCES**

None; appellants, appellants' legal representative, and the assignee are not aware of any other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the presently pending appeal.

**STATUS OF CLAIMS**

The present application is a continuation-in-part of United States Patent Application No. 09/658,977 filed September 11, 2000, which issued May 31, 2005 as U.S. Patent No. 6,901,376. U.S. Patent Application No. 09/658,977 in turn claims the benefit of the filing date of U.S. Provisional Application No. 60/214,632 filed June 28, 2000 and U.S. Provisional Application No. 60/153,183 filed September 10, 1999.

Claims 1-44 were cancelled and replaced with claims 45-112 by Preliminary Amendment filed April 18, 2001. Original claims 1-44 were identical to those filed in U.S. Patent Application No. 09/658,977.

Claims 45-74 were withdrawn by Amendment filed in response to a restriction requirement mailed April 21, 2003. Claims 75-112 remain pending in the application.

Claims 104-110 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claims 75-78, 80-82, 84-90, 93-94, 96-103, and 111-112, stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,088,702 issued to Plantz ("*Plantz*") in view of U.S. Patent No. 6,085,126 issued to Mellgren ("*Mellgren*").

Claims 79, 83, 91-92, and 95, stand rejected as being obvious over *Plantz* and *Mellgren* in further in view of U.S. Patent No. 5,930,810 issued to Farros ("*Farros*").

Claims 104-110 stand rejected as being obvious over *Mellgren* in view of *Plantz*.

#### **STATUS OF AMENDMENTS**

There are no previously unentered amendments and no amendment is submitted herewith.

#### **SUMMARY OF CLAIMED SUBJECT MATTER**

The Applicant submits the following claim summaries in accordance with 37 CFR § 41.37(v). Because of the limited nature inherent in all summaries, any conflict between the summary and the claim language should be resolved in favor of

the claim language, and examples are provided by way of example only, and may not be used to limit the claim element to the specific example.

Applicant also notes, in advance, that Figures 9-14 are particularly relevant to the claims on appeal.

**A. Claims 75, 102 and 111**

The invention of claim 75 provides a method of obtaining information about a personalized product to be provided from a provider to an organization. See, e.g., Specification at page 31, lines 5-6. By way of example only, the invention may provide a webpage for personalizing a stamp. For example, the stamp may be provided by a manufacturer to the organization employing the person who requested the stamp. See, e.g., *id.* at page 30, lines 17-22.

One of the purposes of the invention, according to preamble of claim 75, is for the personalized product to display information provided by the organization. See, e.g., *id.* at page 30, lines 19-22. By way of example only, the stamp may display a company logo.

The method includes receiving login information that identifies a first user within the organization, and a second user within the same organization. The two users must provide different login information. See, e.g., *id.* at page 33, lines

10-19. By way of example, the first user may be an administrator within the organization and the second may be an employee of the same organization.

The method also includes receiving instructions over a network from the first user. These instructions define which aspects of the information have values which may be changed by the second user, such that the instructions define at least one aspect which may be changed and at least one aspect which may not be changed. See, e.g., *id.* at page 31, line 16 to page 32, line 7. By way of example, the administrator may wish to prevent other employees from changing the corporate logo or font sizes, but allow other employees to change their employee identification number.

The method further transmits, to the second user and over the network, the values of aspects of the personalization information. It also transmits an indication which distinguishes the aspects that the second user may change from those that the second user may not change. See, e.g., *id.* at Figure 11, page 33, lines 1-9. This indication is based on both the first user's instruction and the second user's login information. See, e.g., *id.* at page 31, line 16 to page 32, line 7, page 33, lines 15-19.

Finally, the method receives, from the second user and again over the network, the value of an aspect which the second user was able to change and which has changed from the transmitted value. See, e.g., *id.* at page 31, lines 11-15.

Claim 102 recites a system for obtaining information about personalized products comprising a processor for executing instructions. Many of the instructions of claim 102 are similar to the instructions of claim 75, such as: receiving login information identifying a first user and a second user, both within the same but organization having different login information; receiving instructions from the first user that define which aspects of information to be affixed to a product may be changed by the second user; displaying a list of the aspects to a second user where the list indicates which aspects may be changed and which may not based on both the instructions from the first user and the second user's login information; and receiving from the second user the values of the aspects which may be changed.

Claim 111 provides a method of customizing a product to be sold by a provider to an organization. The product includes personalization information to be displayed by the product. Though not identical in subject matter to claim 75, claim 111 receives login information identifying a first user;

permits the first user to store the value of an aspect of the personalization information by determining whether the login information of the first user permits access to storing such value; and receives login information identifying a second user, wherein the login information of the second user is different than the login information of the first user.

Claim 111 additionally sends data about the product over a network to the second user of the organization. The data includes unmodifiable aspects of the personalization information which have values stored by the first user of the organization. The method also provides for receiving the customized values for others aspects of the personalization from the second user. See, e.g., *id.* at Figure 11, page 31, line 16 to page 32, line 7, page 33, lines 1-19.

Yet further, according to claim 111, the product is customized based on the values provided by both the first and second users. See, e.g., *id.* at page 31, line 16 to page 32, line 7.

#### **B. Claims 96 and 103**

The first step of claim 96 requires storing information representing whether a first and second aspect of personalization information is locked or unlocked. If the aspect is locked, then the value of the aspect may not be



changed. Conversely, if the aspect is unlocked, then the value of the aspect may be changed. See, e.g., *id.* at page 32, lines 8-25.

According to claim 96, a web page is sent to the client describing the first and second aspect. If the aspect is locked, then the web page displays the value of the aspect. If the aspect is unlocked, then the web page indicates that the value of the aspect may be changed. See, e.g., *id.* at Figures 10-11, page 32, line 8 to page 33, line 9.

In the last step of claim 96, an instruction is received, from the user, change the information representing whether the first aspect is locked or unlocked. See, e.g., *id.* at page 33, lines 1-5.

Claim 103 recites similar, though not identical subject matter, in means-plus-function format. For example, the claim includes means for storing information representing whether a first and second aspect of the personalization information is locked or unlocked, whereby if an aspect is locked then the value of the aspect may not be changed and if an aspect is unlocked then the value of the aspect may be changed. See, e.g., *id.* at page 32, lines 8-25. As indicated in Figure 1, the structure includes a database 100.

Claim 103 further recites means for sending a web page to the client describing the first and second aspect and, if the aspect is locked then the web page displays the value of the aspect. If the aspect is unlocked, then the web page indicates that the value of the aspect may be changed. See, e.g., *id.* at Figures 10-11, page 32, line 8 to page 33, line 9. As indicated in Figure 1, the structure includes a server 70 having a processor 90 and instructions 80.

Finally, claim 103 recites means for receiving from the user an instruction to change the information representing whether the first aspect is locked or unlocked. See, e.g., *id.* at page 33, lines 1-5. As indicated in Figure 1, the structure includes a server 70 having a processor 90 and instructions 80.

#### **C. Claim 104**

Claim 104 provides a method of receiving personalized information to be displayed on a product. The personalization information has aspects, and in turn the aspects have values. See, e.g., *id.* at page 30, lines 17-22, page 31, lines 5-10.

The method includes receiving locking instructions from a first user, whereby if the instructions identify an aspect as being locked, then the value cannot be changed until the aspect is unlocked. See, e.g., *id.* at page 32, lines 15-25.

The values of aspects are sent to a second user and the method indicates whether the aspect is locked (at least one of the aspects being locked). See, e.g., *id.* at Figure 11, page 33, lines 1-9.

When an instruction is received from the second user to unlock a locked aspect, the aspect value is resent with an indication that the value may now be changed. See, e.g., *id.* at page 33, lines 1-19. The method then receives the value of the prior locked aspect. See, e.g., *id.* at page 31, lines 11-15.

**GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

1. Claims 104-110 rejected under 35 U.S.C. § 101.
2. Claims 75-78, 80-82, 84-90, 93-94, 96-103, and 111-112, rejected under 35 U.S.C. §103(a) over *Plantz* in view of *Mellgren*.
3. Claims 79, 83, 91-92, and 95, rejected over *Plantz* and *Mellgren* in further in view of *Farros*.
4. Claims 104-110 rejected over *Mellgren* in view of *Plantz*.

Applicant also respectfully refers the Board to the detailed discussion of the rejections below.

**ARGUMENT**

**A. Rejection of Claims 104-110 Under 35 U.S.C. § 101**

The Examiner rejected claim 104-110 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Examiner based this rejection on a conclusion that the claimed invention is not within the technological arts.

After the Examiner provided the foregoing rejection, the Board of Patent Appeals and Interferences held in *Ex Parte Lundgren*, 76 U.S.P.Q.2d 1385 (Bd. Pat. App. & Int. 2005) that:

Our determination is that there is currently no judicially recognized separate "technological arts" test to determine patent eligible subject matter under § 101. We decline to create one. Therefore, it is apparent that the examiner's rejection can not be sustained.

The Patent Office's Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility ("Interim Guidelines") further state:

United States patent law does not support the application of a "technical aspect" or "technological arts" requirement. Title 35 of the United States Code does not recite, explicitly or implicitly, that inventions must be within the "technological arts" to be patentable. Interim Guidelines, p. 42.

Therefore, the rejection of claims 104-110 based on an alleged lack of a tie to the "technological arts" should be withdrawn.

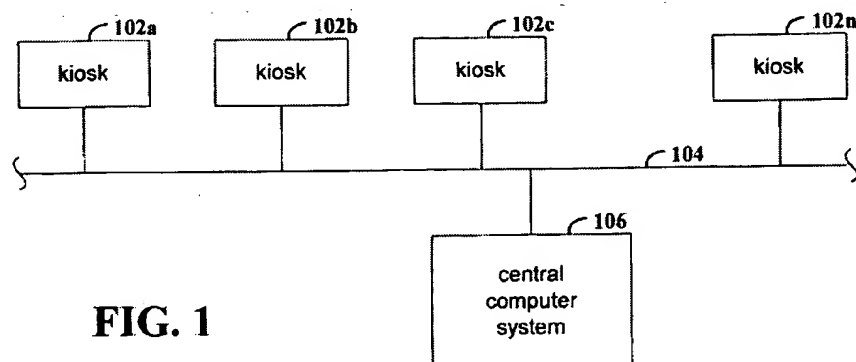
**B. Rejection of Claim 75 under 35 U.S.C.  
§103(a) over Plantz in view of Mellgren**

The Examiner rejected Claim 75 based on the argument that it would have been obvious to combine portions of the disclosures of *Plantz*, U.S. Patent No. 6,088,702 and *Mellgren*, U.S. Patent No. 6,085,126, together.

The obviousness rejection should be overturned for two reasons. First, even if it was obvious to combine the two references, the combination does not teach every element of the claimed invention. Second, it would not have been obvious to combine portions of the references together.

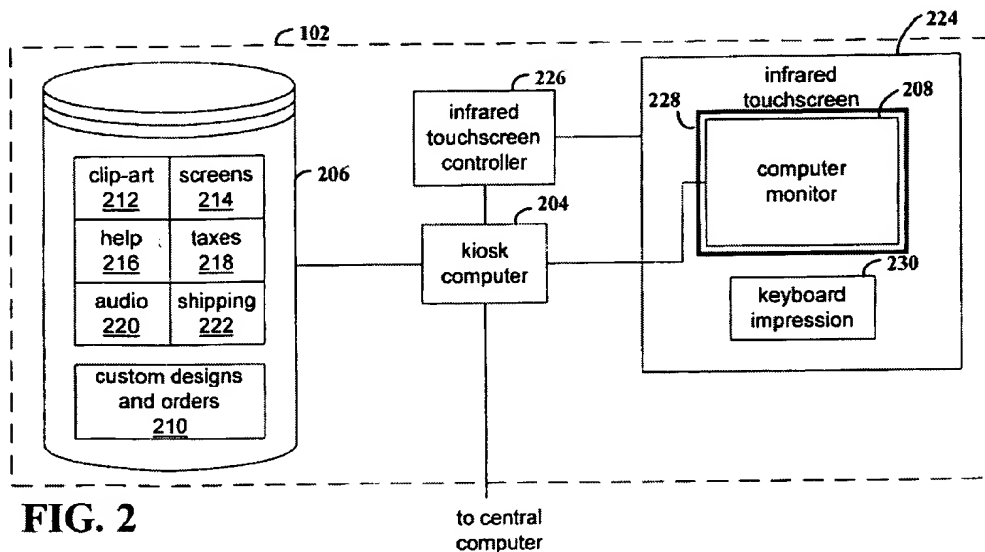
**1. Summary of *Mellgren***

*Mellgren* teaches a collection of kiosks connected to a central computer, as shown in Figure 1.



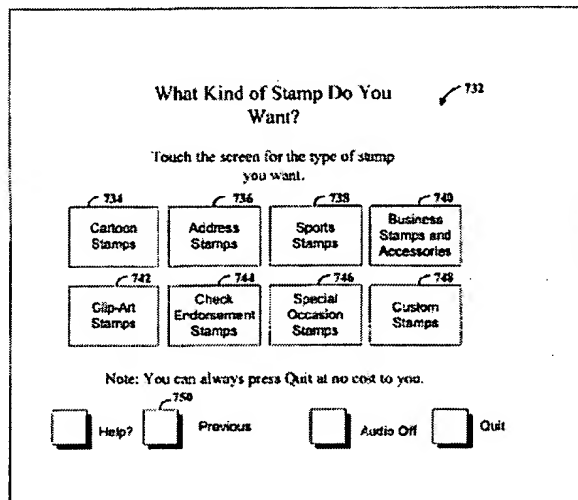
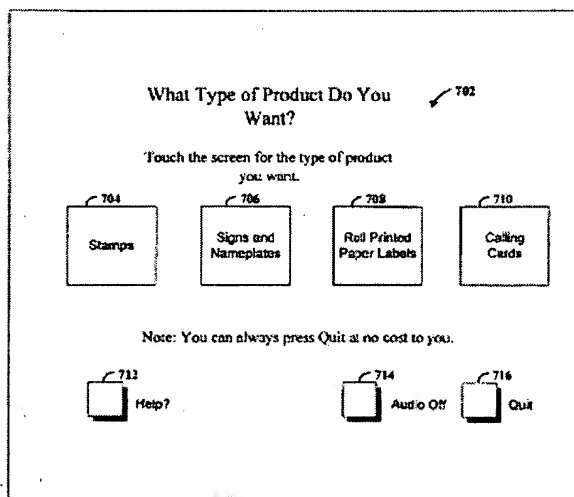
**FIG. 1**

*Mellgren* at Figure 1. The kiosks have touch screens connected to computers, as shown in Figure 2.



Mellgren at Figure 2.

By navigating a series of menus, the user can create personalized items such as stamps. As is typical with menu-driven programs, the menus start broad and get narrower, as shown in many figures such as Figures 7-10:



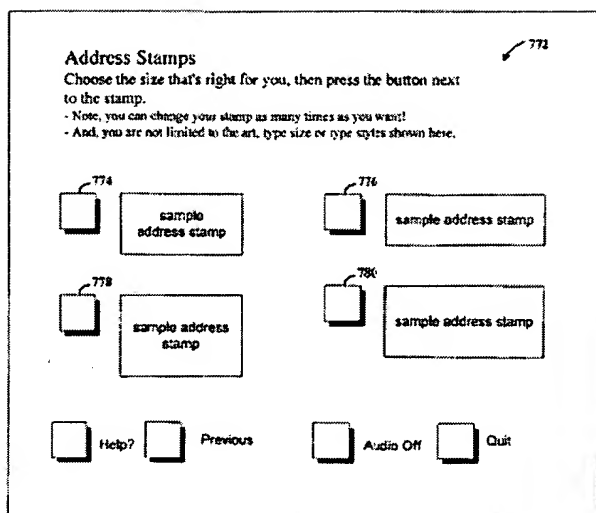


FIG. 9

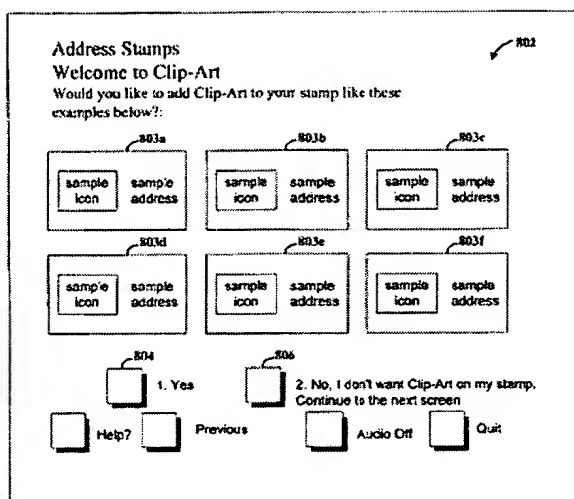
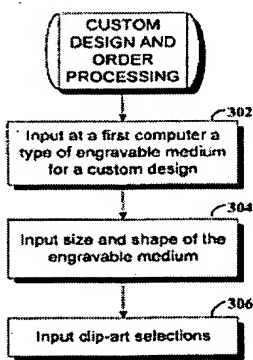
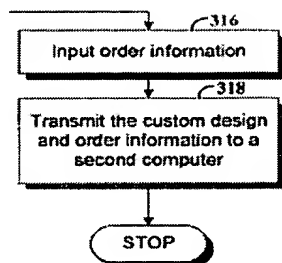


FIG. 10

Mellgren at Figures 7-10.

Once the user is finished making his or her design selections, the user enters his or her order information. The order is then transmitted to the central (also the "second" computer) for processing, as shown in Figure 3:



**FIG. 3**

*Mellgren* at Figure 3 (portions omitted).

**2. The First And Second User  
Elements of Claim 75**

Contrary to the Examiner's assertion, *Mellgren* does not teach the Applicant's claimed elements.

Claim 75 of the current application expressly recites that there must be two users in the same organization. The first user logs in and provides instructions over a network. The instructions define at least one aspect of the personalization information which may be changed, and one aspect which may not:

"receiving login information identifying a first user within the organization;"

"receiving instructions over a network from the first user within the organization, the instructions defining which aspects of the information have values which may be changed by a second user within the organization such that the instructions define at least one aspect which may be changed and at least one aspect which may not be changed;"



Claim 75. By way of example, the administrator may wish to prevent other employees from changing the corporate logo or font sizes, but allow other employees to change their employee identification number. See, e.g., *id.* at page 31, line 16 to page 32, line 7.

The personalization information is then transmitted to a second user who has different login information than the first. This transmission distinguishes those personalization aspects that the second user may change from those that the second user may not:

"receiving login information identifying the second user within the organization, wherein the login information of the second user is different from the login information of the first user;"

"transmitting to the second user over the network the values of aspects and an indication . . . distinguishing the aspects which the second user may change from those which the second user may not change"

Claim 75.

Whether an aspect is indicated as changeable depends on two different criteria: (1) the second user's login information and (2) the first user's instructions. The claim recites:

"transmitting to the second user over the network the values of aspects and an indication, in accordance with the

instructions and based on the second user's login information,"

Claim 75. The second user's login information is used, for example, because some users may have permission to change more aspects than others.

In other words, claim 75 recites at least a method whereby two users communicate over a network such that one user in an organization defines the personalization information that another user can or cannot change. The second user receives an indication of what can be changed, and that indication depends not only on the instructions provided by the first user, but also the login information of the second user as well.

### **3. The Examiner's Primary Contentions Regarding Mellgren**

The Examiner's primary argument regarding the first and second users is as follows.

In the same area of different users obtaining and changing information about a personal product, Mellgren teaches a method and system of receiving instructions over a network from the first user within the organization, the instructions defining which aspects of the information have values which may be changed by a second user within the organization such that the instructions define at least one aspect which may be changed and at least one aspect which may not be changed (Abstract and Figures 3, 7 - 20); transmitting to the second user over the network the values of aspects and an indication, in accordance with the instructions and based on the second user's login information, distinguishing the aspects which the second user may change from those which the second user may not change (Abstract, Col 8, lines 20 - 22 and Figures 7 - 20)

Final Office Action, May 18, 2005 at 4 (portion omitted).

Although the Examiner relies on the abstract of *Mellgren* in support of his contentions regarding the first and second users, the abstract provides no such support. The *Mellgren* abstract states:

[57]

**ABSTRACT**

A system for creating and ordering custom designed imprintable media. The system includes a one or more first computers coupled to a central computer. The first computers are configured and arranged to input a type indicating one of a plurality of imprintable media, custom design information to engrave on an imprintable medium of the type input, and order information, and to display an image of the custom design to appear on the imprintable medium. Example custom design information includes text, clip-art, and size and shape of the imprintable medium. Custom designs and orders are automatically transmitted to a second computer for order processing.

Indeed, *Mellgren's* abstract does not even mention users, let alone one user sending instructions regarding what another user can and cannot change. Rather, the abstract merely states that a first computer is used to enter information to be engraved on a media, and a second computer is used to process the order for the media.

The Examiner relies on Figure 3. Applicant has reproduced this figure above and, as can be readily seen, this figure shows nothing more than a first computer which is used to enter and send personalization information to a second computer.

The Examiner also relies on Figures 7-20, i.e., the screen shots of the menus by which a user enters the personalization information. Applicant does not contest that the menus provide a user with options for entering personalization information. However, there is nothing in these screen shots which indicates the presence of any users other than the user entering the personalization information. Therefore, the figures do not and cannot teach a first and second user with different login information.

The Examiner further relies on lines 20-22 of column 8 of *Mellgren*, which are reproduced below in their full context.

- 15     FIG. 13 is an image of an example user interface screen for entry of address text for an address stamp. As the user enters address information at keyboard impression 230, kiosk computer 204 displays the address information in image box 844 on monitor 228 which is viewable through  
20     the touchscreen 224. As indicated by instructions 1, 2, and 3, conventional word processing techniques are used for entering address information. When the user finishes entering address information, the next button 848 must be pressed to continue creating the customized address stamp. Touching  
25     button 848 causes kiosk computer 204 to display a user interface screen for selection of further formatting of the address stamp as shown in FIG. 14. Alternatively, the user may touch purchase button 864 to proceed to the purchase screen of FIG. 21.

Like the prior portions of *Mellgren* relied upon by the Examiner, this passage teaches nothing more than a single user entering in his or her personalization information.

**4. Mellgren Does Not Disclose  
A First Or Second User As Claimed**

In response to Applicant's previous arguments, the Final Rejection includes new arguments. For example, the Examiner contends:

Please note instructions are provided by the first user/entity for the second user/entity as indicated at the above reference citations of Mellgren. For example in Figures 8, 9 and 10, the second user/entity is provided overall as well as specific instructions from the first user/entity of which aspects can be changed such as type of stamp or address.

Final Office Action, May 18, 2005 at 5.

Figures 8-10 do not support the Examiner's contention. As noted above, Applicant does not contest that *Mellgren* teaches a menu that provides a user with options for entering personalization information. However, there is nothing in the figures which indicate that another user, with different login information, provided instructions regarding what the second user could or could not change.

Indeed, the Final Rejection never identifies which person or computer in *Mellgren* is serving the function of the claimed first user and which person or computer is serving the function of the claimed second user.<sup>1</sup> For example, one of the

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<sup>1</sup> Throughout the final action, the Examiner uses the term "user" and "computer" interchangeably. For the purposes of this brief, it appears unnecessary to address the differences and similarities between computers and their users. However, in the event the Examiner submits new arguments in

Examiner's new arguments refers to a "first user/entity" and a "second user/entity," one of which is apparently the "kiosk/computer:"

Moreover, Mellgren further suggest and teaches one of ordinary skill that instructions are transmitted from the first user/entity to the kiosk/computer device via a network, with distinguish aspects that can not be changed by a second user/entity (Col 4; lines 58 – 65 and Figures 5 and 8 -10). In turn, the second user/entity transmits the selected value changes back to the first user/entity of the aspects they can and have changed (Col 4, lines 58 – 65 Figures 7 – 20).

In that regard and in a reasonable interpretation of the word "instructions", the instructions with respect to the aspects that can be changed by the second user – sent from the first user disclose a "technical procedure" method by the series of instructions provided at each step as the second user proceeds through the screens/figures 8 – 12. In turn, these aspect/value changes by the second user/entity are sent back to the first user/entity.

Final Office Action, May 18, 2005 at 5 (portions ommited). In support, the Examiner turns once again to the menus of Figures 7-20. As noted above, there is nothing in these screen shots which indicates the presence of any users other than the user entering the personalization information.

It appears that the Examiner may be analogizing the kiosk of *Mellgren* to the second user of the Applicant's claims. If so, the Examiner has not identified who the first user is in *Mellgren*. The omission may be because *Mellgren* does not teach a

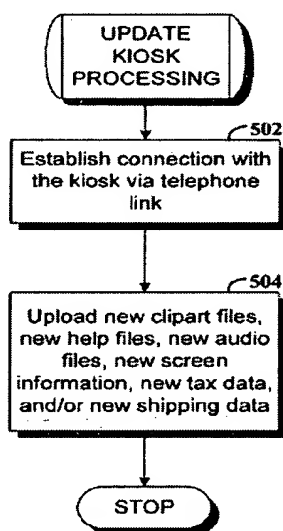
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reply which relate to this issue, Applicant reserves the right to address that issue.

first user as recited in claim 75. For example, the Examiner relies on the following passage:

In another example embodiment, the functions provided by the kiosk computer 204 may be provided by a network  
60 appliance or personal computer coupled to the World Wide Web (WWW), where a computer system, such as computer system 106, for example, hosts a WWW site. Such a WWW site may contain the design files 212-222 in the form of  
65 HyperText Markup Language (HTML) pages or downloadable programs such as Java applets, for example.

Mellgren at col. 4, lns. 58-65. The Examiner also relies on the following figure:



**FIG. 5**

Mellgren at Figure 5.

However, neither the *Mellgren* specification nor figure identifies which computer which is sending the information to kiosk. Even if one assumes that *Mellgren's* Central Computer System 106 is the computer which provides the menus to the kiosk, there is still nothing in *Mellgren* which teaches that a

user at the Central Computer meets the requirements of the first user of claim 75:

"receiving login information identifying a first user within the organization [which is different from a second user in the same organization];"

"receiving instructions over a network from the first user within the organization, the instructions defining which aspects of the information have values which may be changed by a second user within the organization such that the instructions define at least one aspect which may be changed and at least one aspect which may not be changed;"

Perhaps the Examiner is arguing that the programmer of *Mellgren's* menu options is the first user of the Applicant's claims. However, there is no suggestion that the programmer - who is not even identified in *Mellgren* - would be in the same organization as the second user. If anything, the programmer is going to be member of the stamp provider (*i.e.*, the kiosk provider) and not in the same organization as the person ordering the stamp. See, *e.g.*, Claim 75 (the "personalized product [is] to be provided from a provider to an organization"). One of the advantages of the present invention is that it allows someone who is not in the business of providing stamps to restrict the information that other people in the same organization can put on stamps. Given that neither *Mellgren* nor the Examiner identifies any such programmer, it is



also no wonder that *Mellgren* similarly fails to teach a programmer having different login information as the second user.

Thus, even in combination, *Platz* and *Mellgren* fail to teach users that meet the requirements of the first and second users of claim 75. Claim 75, and its dependant claims, should be allowed on this basis alone.

**5. Neither *Plantz* Nor *Mellgren*  
Teaches That The First And Second  
Users Are In The Same Organization  
That Receives The Product**

The Examiner relies on *Plantz* as teaching the following:

Regarding claim 75 and related claims 96, 102, 103 and 111 (previously presented), *Plantz* teaches a method of obtaining information about a personalized product to be provided from a provider to an organization, the personalized product displaying information provided by the organization, the method comprising the provider: receiving login information identifying a first user within the organization (Col 5, line 66, Col 6, lines 61 – 62 and Figures 1 and 2); receiving login information identifying the second user within the organization, wherein the login information of the second user is different from the login information of the first user (Col 7, lines 31 – 33).

Final Office Action, May 18, 2005 at 3.

As an initial matter, the Applicant notes that regardless of *Plantz's* teachings, Applicant accepts for the purposes of the instant appeal that systems exist whereby a

user's login information defines what the user can and cannot change on a system.

But claim 75 further requires that the first and second user be within the same organization that gets the personalized product. In response to this claim element, the Examiner states:

Also, please note that Plantz defines the method and means as occurring *within* an organization requiring separate user login(s). Accordingly, Mellgren discloses the method as well as the means *within* the organization required to provide instructions from a first user/entity to a second user/entity with regard to aspects/values that can and cannot be changed as well as the second user/entity transmitting these permitted aspect changes back. Of note, the applicant's specification gives several examples of users but never defines a first user or second user as well as organization other than that company A (first entity) sells products to Company B (second entity) and thereby labels this stored data as an "organization" (Page 43, lines 9 - 11). In this manner and Mellgren would fairly suggest and teach one of ordinary skill that, A (first user/entity) is selling products to B (second user/entity) and these would be stored under a labeling appropriate for this stored data in the specific account for this and other transactions *only* associated with this account/business relationship.

Final Office Action, May 18, 2005, at pages 6-7. The Examiner is simply incorrect when he implies that the Applicant's specification does not teach, and claim 75 does not recite, that the two users are members of the same organization that receives the personalized product.

The Applicant's specification expressly states that the ability to lock and unlock information is not always

available "to every user within an organization" but, rather, may be limited to only "certain people within an organization." Applicant's Specification at page 33, lines 10-19.<sup>2</sup> Moreover, the preamble of claim 75 expressly recites "a method of obtaining information about a personalized product to be provided from a provider to an organization." The claim further stats that the "first user [is] within the organization" and that "the second user [is] within the organization."

There is nothing in *Mellgren* which indicates that two different kiosk users are in the same organization, and that the organization receives the product. *Platz* also does not recite that the organization receives a personalized product.

Thus, even in combination, *Platz* and *Mellgren* fail to teach that the first and second users are in the same organization that receives the product. Claim 75, and its dependant claims, should be allowed on this basis alone.

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<sup>2</sup> Applicant notes that while the word "not" is missing from between the words "is" and "always" at page 33, line 11, the word "not" is obviously implied from the context of the remainder of the paragraph. For example (and regardless), the next sentence specifically stats that the ability to lock and unlock information may be limited to certain people such as administrators.

**6. It Is Not Obvious To  
Combine Mellgren And Plantz**

Even if portions of *Mellgren* and *Plantz* collectively teach every element of the claimed invention, it is not obvious to combine the two references.

First, there is there is absolutely no suggestion or motivation in *Mellgren* to use the log-in information of a user to limit what aspects the user can and cannot change. The very first paragraph of the detailed description indicates that the purpose of the invention is to provide kiosks for use by consumers.

The present invention is believed to be applicable to a variety of systems and arrangements for consumers to custom design imprintable media such as rubber stamps, 45 signs and name plates, labels and calling cards. The invention has been found to be particularly advantageous in an application environment where a plurality of kiosks are coupled to a central computer system, the kiosks being available for consumers to create custom designs and order 50 products. While the present invention is not so limited, an appreciation of various aspects of the invention is best gained through a discussion of application examples operating in such an environment.

*Mellgren* at col. 3, lines 43-54. It would run counter to the consumer-oriented nature of *Mellgren* for the stamp seller to limit what the second user can and cannot change based on who the second user is.

In this regard, it is only with the benefit of hindsight that *Mellgren* would be combined with *Plantz*. As the Federal Circuit has stated:

Prior art references may be considered to teach away when "a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant."

*Monarch Knitting Mach. Corp. v. Fukuhara Indus. & Trading Co.*, 139 F.3d 977 (Fed. Cir. 1998) (citing *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed.Cir.1994)).

The Examiner argues that the *Mellgren* is not limited to consumer kiosks. Final Office Action, May 18, 2005, at page 5. True or not, *Mellgren* is limited to consumer applications. There is no indication or suggestion anywhere in *Mellgren* that the service provider may limit what the second user can and cannot do based on the second user's identity, whether in a kiosk atmosphere or otherwise. Again, this suggestion runs counter to a conventional service provider theory. It is the nature of consumer-oriented industries to provide the consumer with more options, not less. Thus, it is only with the benefit of hindsight that *Mellgren* would suggest this teaching and be combined with *Plantz*.

*Mellgren* and *Plantz* are directed to different purposes. *Mellgren* teaches menus which navigate a customer to different possible customizations. There is no suggestion in *Mellgren* that those menus are configurable so that one user can define what another user can change, or that the users are part of the same organization. There is also no suggestion or teaching that the menus change based on the identity of the second user. *Plantz* teaches that users within an organization may have limited access to personalized information based on a login authentication. Combining these references together runs counter to their intended purposes.

Thus, even in combination, *Platz* and *Mellgren* fail to teach that the first and second users are in the same organization that receives the product. Claim 75, and its dependant claims, should be allowed on this basis alone.

**C. Rejection Of Claims 102 And 111, And Claim 111's  
Dependant Claim (Claims 112), Under 35 U.S.C.  
§103(a) Over *Plantz* In View Of *Mellgren***

Many of the foregoing arguments apply equally to independent claims 102 and 111 (and may be treated as group for the purposes of this appeal and prior art discussed herein only).

For example, claim 102 recites a system comprising instructions, where those instructions include:

- receiving different login information from a first and second user in the same organization; and
- displaying a list of the aspects of personalization information to a second user, and indicating which aspects may be changed and which may not based on the instructions from the first user and based on the second user's login information.

As explained above, *Mellgren* and *Plantz* do not teach such elements, either alone or in combination.

Claim 111 recites similar elements, such as:

- receiving different login information identifying a first user and a second user; and
- sending data about the product over a network to the second user, the data including unmodifiable aspects of the personalization information which have values stored by the first user of the organization.

Therefore, allowance of claims 102 and 111, and their dependant claims, is respectfully requested.

**D. Rejection of Claims 96 and 103, and  
its dependant claims, under 35 U.S.C.  
§103(a) over Plantz in view of Mellgren**

The Final Office Action purports to reject independent claim 96 and 103, as well as various of their dependant claims, based on the same art as claim 75.

**Claims 75 – 78, 80 – 82, 84 – 90, 93, 94, 96 – 103 and 111 – 112 are rejected  
under 35 U.S.C. 103(a) as being unpatentable over Plantz (US 6,088,702) in view of  
Mellgren (US 6,085,126).**

However, the Final Office Action never explained why claims 96 and 102 were rejected.

In fact, claim 96 recites different limitations than claim 75. The first step of claim 96 requires storing information representing whether a first and second aspect of the personalization information is locked or unlocked. If the aspect is locked, then the value of the aspect may not be changed. Conversely, if the aspect is unlocked, then the value of the aspect may be changed.

According to claim 96, a web page is sent to the client describing the first and second aspect. If the aspect is locked, then the web page displays the value of the aspect. If the aspect is unlocked, then the web page indicates that the value of the aspect may be changed.

The last step of claim 96 is "receiving from the user an instruction to change the information representing whether



the first aspect is locked or unlocked." This step does not recite simply receiving the information representing the value of the aspect, such as the name of a person. Rather, it states receiving an instruction from the client to change whether the aspect is locked or unlocked. As noted above, claim 96 expressly defines "unlocked" and "locked" as representing whether the value may be changed or not.

As far as the undersigned can tell, the Office Action does not appear allude to any portion of *Mellgren* or *Plantz* which teaches this feature of receiving an instruction from the client to change whether the aspect is locked or unlocked. Moreover, the undersigned is not aware of any portion of *Mellgren* or *Plantz* which teaches, or even suggests, this feature.

Similarly, *Mellgren* and *Plantz* also fail to teach the elements of claim 103:

103. (previously presented) A system of allowing a user to provide personalization information over a client/server network, the system comprising:

means for storing information representing whether a first and second aspect of the personalization information is locked or unlocked, whereby if an aspect is locked then the value of the aspect may not be changed and if an aspect is unlocked then the value of the aspect may be changed,

means for sending a web page to the client describing the first and second aspect and, if the aspect is locked then the web page displays the value of the aspect and, if the aspect is unlocked, then the web page indicates that the value of the aspect may be changed, and

means for receiving from the user an instruction to change the information representing whether the first aspect is locked or unlocked.

Accordingly, allowance of claims 96 and 103, and all claims dependant thereon, is respectfully requested.

**E. Rejection of Claim 104, and its  
dependant claims, under 35 U.S.C.  
§103(a) over Mellgren in view of Plantz**

As summarized above, the invention of claim 104 is generally directed to a method of receiving personalized information to be displayed on a product, where the personalized information has aspects and the aspects have values. The method comprises, among others, the steps of:

- receiving locking instructions from a first user to lock certain aspects
- sending values of aspects to a second user and indicating whether the aspect is locked
- receiving instructions from a second user to unlock a locked aspect, and

- resending the value of the prior locked aspect to the second user with an indication that the value may now be changed.

The disclosures of *Mellgren* and *Plantz* are discussed above, and those comments are incorporated herein by reference. As discussed, neither the *Mellgren* nor *Plantz* references disclose first and second users, where the first user may lock aspects. Further, there is no teaching whereby a second user may send a request to unlock the aspects, where an unlocked value of the previously locked aspect is sent to the second user with an indication that the value may be changed.

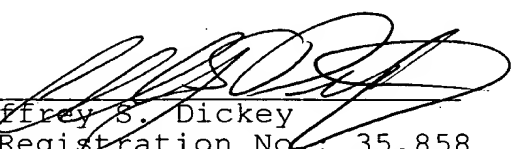
For these and other reasons, claim 104 is deemed allowable over *Mellgren* in view of *Plantz*.

#### **CONCLUSION**

Applicant respectfully requests that the pending claim rejections be reversed, and the claims allowed to issue as presented.

Dated: March 22, 2006

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**APPENDIX A - CLAIMS**

75. A method of obtaining information about a personalized product to be provided from a provider to an organization, the personalized product displaying information provided by the organization, the method comprising the provider:

receiving login information identifying a first user within the organization;

receiving instructions over a network from the first user within the organization, the instructions defining which aspects of the information have values which may be changed by a second user within the organization such that the instructions define at least one aspect which may be changed and at least one aspect which may not be changed;

receiving login information identifying the second user within the organization, wherein the login information of the second user is different from the login information of the first user;

transmitting to the second user over the network the values of aspects and an indication, in accordance with the instructions and based on the second user's login information, distinguishing the aspects which the second user may change from those which the second user may not change; and

receiving from the second user over the network the value of an aspect which may be changed in accordance with the instructions and which has changed from the transmitted value.

76. The method of claim 75 wherein the step of transmitting includes sending the list in a web page to the second user.

77. The method of claim 75 wherein the information to be displayed comprises graphics or text to be personalized on the product.

78. The method of claim 75 wherein the product is a stamp.

79. The method of claim 75 wherein the product is an advertising specialty.

80. The method of claim 75 wherein the aspect includes the content of the information.

81. The method of claim 75 wherein the aspect includes how the information should be formatted.

82. The method of claim 81 wherein the formatting relates to one of more of the font, font size, font style, position or alignment of the information.

83. The method of claim 75 wherein the information constitutes a logo.

84. The method of claim 75 wherein the information constitutes a picture chosen by a user.

85. The method of claim 75 further including at least one of the users modifying the instructions so as to modify whether an aspect may be changed or not.

86. The method of claim 85 further comprising the first user modifying the instructions so as to modify whether an aspect may be changed or not.

87. The method of claim 85 further comprising the second user modifying the instructions so as to modify whether an aspect may be changed or not.

88. The method of claim 85 wherein the step of modifying the instructions comprises sending a web page to the at least one user listing the aspect to be changed and allowing the user to click a control to change the instructions associated with the aspect.

89. The method of claim 88 wherein the control is a checkbox.

90. The method of claim 75 wherein the indication is the appearance of the area for accepting user input of the value.

91. The method of claim 90 wherein a three-dimensional textbox indicates that the aspect may be changed.

92. The method of claim 75 wherein the first user and the second user are the same person.

93. The method of claim 75 wherein the first user and the second user are different people.

94. The method of claim 75 further comprising associating a login or password with the instructions, and wherein the instructions cannot be changed by the first user or

second user unless the first user or the second user had provided a valid login or password.

95. The method of claim 75 further comprising displaying the personalized information simultaneously with the aspect values to the second user.

96. A method of allowing a user to provide personalization information over a client/server network, the personalization information used to personalize a product, the method comprising:

storing information representing whether a first and second aspect of the personalization information is locked or unlocked, whereby if an aspect is locked then the value of the aspect may not be changed and if an aspect is unlocked then the value of the aspect may be changed,

sending a web page to the client describing the first and second aspect and, if the aspect is locked then the web page displays the value of the aspect and, if the aspect is unlocked, then the web page indicates that the value of the aspect may be changed, and

receiving from the user an instruction to change the information representing whether the first aspect is locked or unlocked.

97. The method of claim 96 further comprising, after the step of receiving, sending a web page to the client describing the first aspect and, if the first aspect is locked then the web page displays the value of the aspect and, if the

aspect is unlocked, then the web page indicates that the value of the aspect may be changed.

98. The method of claim 97 wherein at least one of the aspects relates to the content of personalization information to be affixed to a stamp and the value of the at least one aspect relates to the content.

99. The method of claim 98 wherein the content identifies an entity.

100. The method of claim 96 wherein the aspect relates to the formatting of personalization information to be affixed to a stamp.

101. The method of claim 96 wherein, if the aspect is unlocked, then the web page also displays the value of the aspect.

102. A system for obtaining information about personalized products comprising:

a processor for executing instructions, and

instructions including:

receiving login information identifying a first user within the organization;

receiving login information identifying a second user within the organization, wherein the login information of the second user is different from the login information of the first user;



receiving instructions from a first user, the instructions defining which aspects of personalization information to be affixed to a product may be changed by a second user; displaying a list of the aspects to a second user, the list indicating which aspects may be changed and which may not be based on the instructions from the first user and based on the second user's login information; and receiving from the second user the values of the aspects which may be changed.

103. A system of allowing a user to provide personalization information over a client/server network, the system comprising:

means for storing information representing whether a first and second aspect of the personalization information is locked or unlocked, whereby if an aspect is locked then the value of the aspect may not be changed and if an aspect is unlocked then the value of the aspect may be changed,

means for sending a web page to the client describing the first and second aspect and, if the aspect is locked then the web page displays the value of the aspect and, if the aspect is unlocked, then the web page indicates that the value of the aspect may be changed, and

means for receiving from the user an instruction to change the information representing whether the first aspect is locked or unlocked.

104. A method of receiving personalized information to be displayed on a product, the personalization information

having aspects, the aspects having values, the method comprising:

receiving locking instructions from a first user, whereby if the instructions identify an aspect as being locked, then the value cannot be changed until the aspect is unlocked;

sending values of aspects to a second user and indicating whether the aspect is locked, at least one of the aspects being locked;

receiving an instruction from a second user to unlock a locked aspect;

resending the value of the prior locked aspect to the second user with an indication that the value may now be changed; and

receiving the value of the prior locked aspect.

105. The method of claim 104 further comprising indicating which values are unlocked during the step of sending the values.

106. The method of claim 105 wherein: the step of sending and resending values comprises sending a web page containing controls capable of receiving input from a user; and the step of receiving instructions relating to locking and unlocking comprises sending a web page with controls allowing the user to indicate which aspects may be locked or unlocked and receiving the values of the controls from the user.

107. The method of claim 106 wherein the step of sending further includes placing the value in a user-modifiable textbox to indicate that the value's associated aspect is unlocked.

108. The method of claim 104 further including enabling one of the users to unlock an aspect and disabling the other user from unlocking the same aspect.

109. The method of claim 108 further including receiving a login or password from the users.

110. The method of claim 109 further including determining whether a user is enabled or disabled from unlocking an aspect based on the user's login or password.

111. A method of customizing a product to be sold by a provider to an organization, said product including personalization information to be displayed by the product, said method comprising:

receiving login information identifying a first user;

permitting a first user to store the value of an aspect of the personalization information by determining whether the login information of the first user permits access to storing such value;

receiving login information identifying a second user, wherein the login information of the second user is different than the login information of the first user;

sending data about said product over a network to the second user of the organization, the data including unmodifiable aspects of the personalization information which have values stored by the first user of the organization;

receiving, from the second user, customized values for other aspects of the personalization information; and

customizing the product based on the values provided by both users.

112. The method of claim 111 wherein the sent data includes information relating to where the aspects are displayed on the product.

Application No.: 09/677,153

Docket No.: M&R 3.0-033 CIP

**APPENDIX B - EVIDENCE**

NONE

Application No.: 09/677,153

Docket No.: M&R 3.0-033 CIP

**APPENDIX C - RELATED PROCEEDINGS**

NONE